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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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KEIL & WEINKAUF
1101 CONNECTICUT AVENUE NW
WASHINGTON DC 20036

IM62/0803

EXAMINER

RAJGURU, U

ART UNIT

PAPER NUMBER

1711

6

DATE MAILED:

08/03/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☐ Responsive to communication(s) filed on _____.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-22 is/are pending in the application.
Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-22 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☒ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
- *Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

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Claims 17 -19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 17-19 provide for the use of the film made from (claimed) composition, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 17-19 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd. App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

2. Claims 5, 7, 8, 9, 12, 13 and 14 and 16 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. See MPEP 608.01 (n). Accordingly, the claim have not been further treated on the merits.

3. Claims 1, 2 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 6 recites words "on average" in a parenthesis. It is not known if the matter in the parenthesis is or is not encompassed by the scope of this claim.

Claim 1 recites matter in parenthesis in lines 12-13.

claim 1 is further indefinite since it is not known how low can the value of pK be and how high HLB can be.

Claim 2 is indefinite in reciting "3 or more carbon atoms" and "2 or more alcohol groups" because one cannot know precisely how many carbon atoms or how many alcohol groups are envisioned.

4. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

5. The disclosure is objected to because of the following formalities:

Words "selected from compounds" in claim 1, lines 8-9, should be replaced with -- which is one of the --.

Hyphen in claim 1 line 9 and dash in line 10 should be deleted.

Appropriate correction is required.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-4, 6, 10, 11, 15 and 17-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krishnan et al (WO 95/24447).

(Krishnan is of record on PTO-1449).

Krishnan discloses compatibilized blends of a biodegradable hydrophobic polyester, unmodified starch or other similar polysaccharide, other biodegradable polymers, plasticizers and additives. The polymer forms a continuous phase while starch forms a discontinuous one. A preferred biodegradable polymer is poly (E-caprolactone) (p. 7 line 20). Organic plasticizers, such as esters are included in the blend (p. 15, lines 21-30). Compatibilizers are also used (p. 13, lines 18-35). Also included in the blend may be certain additives that function as binders by complexing with starch (p. 19, lines 10-16). They include monoglycerides.

Krishnan does not mention the (claimed) dissociation constant pK and hydrophilic lipophilic balance index value HLB of the ester. Since Krishnan broadly teaches the (claimed)

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glycerides, it is reasonable to assume that glycerides of Krishnan possess these properties.

Therefore it would have been obvious to follow teachings of Krishnan and arrive at instant invention. Since no criticality has been established for claimed pK to be lower than 4.5 and HLB to be greater than 8, instant claims are deemed to be prima facie obvious over Krishnam.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to U. K. Rajguru whose telephone number is (703) 308-3224. The examiner can normally be reached on Monday-Friday from 9:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Seidleck, can be reached on (703) 308-2462. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3599.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



U. Rajguru/vr

07-26-00

07-31-00

James J. Seidleck
Supervisory Patent Examiner
Technology Center 1700